

REMARKS

Claims 1-62 are pending in this application. Claims 1 and 30 are independent claims. By this amendment, claims 1 and 30 are amended for clarity.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Copies of Initialed PTO-1449 Requested

Applicant respectfully requests a copy of the initialed PTO-1449 submitted on July 12, 2001.

In reviewing the application file, the undersigned has noted that the appropriate initialed Form PTO-1449 in response to the Information Disclosure Statement (IDS) filed on July 12, 2001 has not been received by Applicant. The Examiner is therefore requested to return a copy of the initialed Form PTO-1449 to the undersigned as soon as possible.

The Claims Define Patentable Subject Matter

Concerning pending claims 1-62, the Office Action makes the following rejections:

(1) claims 1-6, 14, 30-34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent No. 09-37125 to Tamura (hereafter Tamura) in view of U.S. Patent No. 6,545,687 to Scott et al. (hereafter Scott);

(2) claims 7-11, 35-37 and 39-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and

further in view of U.S. Patent No. 6,784,925 to Tomat et al. (hereafter Tomat);

(3) claims 12 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Patent No. 5,737,491 to Allen et al. (hereafter Allen);

(4) claims 13 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Patent No. 6,188,431 to Oie (hereafter Oie);

(5) claims 15-21, 29, 46-51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and further in view of U.S. Publication No. 2002/0101440 to Niikawa et al. (hereafter Niikawa);

(6) claims 22-26, 52-54 and 56-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Tomat;

(7) claims 27 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Allen; and

(8) claims 28 and 62 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tamura in view of Scott and Niikawa and further in view of Oie.

These rejections are respectfully traversed.

Although a plurality of combinations of references are applied in rejecting claims 1-62, it is apparent that the Examiner is mainly relying upon the combination of Tamura and Scott.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of Tamura and Scott for at least the following reasons:

The Examiner alleges that Tamura discloses a communication device that transmits main image data stored in a storage medium to an external apparatus and keeps the main image data in the storage medium. (see Office Action, page 2, paragraph 2). The Examiner further states that Tamura teaches transmitting main image data and storing main images in the memory after the main images are transmitted but fails to teach specifically that the stored image data can be reduced image data instead of the main image data. (see Tamura, paragraph [0019] -[0021]).

In essence, the Examiner is focusing on what Tamura does with the image data after it is transferred. However, applicant respectfully submits that the Examiner is missing a key aspect of the invention which is to save a different form of the main image data after it is transmitted and deleted.

In other words, in the present invention reduced image data is produced from the main image data and this reduced image data is stored in the storage medium upon deletion of the main image data, for example.

In contrast with the present invention, Tamura merely stores the main image data as it is and Tamura is completely silent about

storing a reduced form of the main image data. (see Tamura, paragraph [0021]).

Furthermore, Tamura fails to teach or suggest any means for recovering deleted main image data. Tamura merely discloses that the main image data is sometimes left in the memory as it is after it is transmitted. However, Tamura's leaving of main image data as it is in the memory after a transfer is not the same as producing reduced image data after a deletion of main image data.

In an attempt to show this reduced image data feature, the Examiner imports Scott. As for Scott, the Examiner alleges that Scott discloses that thumbnail images are stored instead of main images. As such, the Examiner alleges that the combined teachings of Tamura and Scott would have made it obvious to one skilled in the art ... to store reduced image data in the storage medium after the main images are transmitted. The Examiner's motivation for combining Tamura with Scott is that if a trouble is caused, the main image data can be recovered at a later time if it is left in the memory after the transfer, as taught in paragraph 19 of Tamura. (see Office Action, pages 2-3, paragraph 2).

However, a close review of paragraph 19 of Tamura reveals that Tamura is directed towards leaving the main image data as it is in the memory after a transfer. Tamura is not at all concerned with changing the form of the main image data, i.e., transforming the data to thumbnails. Nor is Tamura concerned with keeping a different form of the main image data after a deletion step.

Tamura merely discloses keeping the main image data as it is after a transfer step. (see Tamura, paragraphs [0019-[0021])). Nothing in Tamura teaches what happens to the data after a deletion step, i.e., keeping a reduced form of the data after a deletion step as set forth in claims 1 and 30.

As for Scott, Scott says nothing at all about deleting main image data and producing reduced image data thereafter. Scott is merely concerned with manipulating thumbnails. As such, applicant respectfully submits that Scott fails to make up for the deficiencies found in Tamura.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that not only does the combination of Tamura and Scott fails to teach or suggest each and

every feature as set forth in independent claims 1 and 30 as noted above, but the Examiner has also failed to provide proper motivation for combining Tamura and Scott.

Applicant respectfully submits that the Examiner asserted motivation for combining Scott and Tamura fails to address why Tamura would want to store thumbnails for later usage. From our review of Tamura, we find no teaching or suggestion to support the examiner's asserted motivation to combine the references so that the main image data can be recovered at a later time if it is left in the memory after the transfer. Tamura already keeps the main image data, as it is, in the memory. However, nothing in Tamura talks about keeping a different form of the data, i.e., a thumbnail, in the memory. Tamura is not at all concerned with changing the form of the main image data into a thumbnail. On the other hand, Scott is mainly concerned with thumbnail manipulations. And, both Scott and Tamura fail to be concerned with storage of the image data after a deletion step.

As such, the examiner's motivation statement fails to address what exactly is being combined and also fails to address a key aspect of the present invention.

Applicant respectfully submits that but for applicant's own disclosure of the specific features involved, i.e., the data form, and the storage thereof after specific steps, the applied references themselves would not have instructed one versed in the

art on how to go about selectively reworking and modifying Tamura's device/process to yield applicant's claimed invention.

Accordingly, applicant submits that the Examiner's 103(a) rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

In addition, applicant submits that the Office Action has improperly used applicant's invention as a road map to pick and choose features and paste the chosen features together to arrive at the claimed invention, even though the cited references do not provide any teachings, suggestion or motivation to make the modification.

Applicant respectfully submits that the combination of Tamura and Scott fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claims 1 and 30 are allowable over the combination of Tamura and Scott for at least the reasons noted above.

Furthermore, applicant respectfully submits that Tomat, Allen, Oie, and Niikawa all fail to make up for the deficiencies found in the combination of Tamura and Scott noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

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Accordingly, withdrawal of the rejection of claims 1-62 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

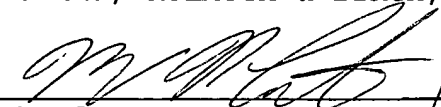
Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.


Respectfully submitted,

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